UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte LIDA NOBAKHT and JAMES R.W. CLYMER

_____

Appeal 2016-000939
Application 12/257,154
Technology Center 2400

_____

Before ELENI MANTIS MERCADER, CATHERINE SHIANG, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's
rejection of claims 1–5, 7–13, 15, 16, 18, 25, and 28–32, which are all the
claims pending and rejected in the application. We have jurisdiction under
35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Introduction

The present invention relates to multimedia associated with a smart
card. *See generally* Spec. 1. Claim 1 is exemplary:

1.   A method of accessing data on a server by a user at a client system,
access being controlled by a user specific smart card issued to said user, said

client system providing an interface for said user to access said server, comprising:

 reading user specific information from said smart card by said client system, said information including a user specific electronic serial number;

 transmitting said user specific information to said server;

 processing said user specific information by said server to determine user authorization to access data; and

 providing said user is authorized, receiving data from said server by said user at said client system;

 wherein said smart card includes a read-only memory for storing personal identification data, wherein said user specific information includes said personal identification data,

 the method further comprising blowing a fuse on said smart card after said personal identification data is stored thereon, thereby forming said read-only memory, wherein said smart card includes an encryption program for encrypting said personal identification data, and wherein said data received from said server permits said client system to access user specific information from said smart card,

 the method further comprising:

 each time said user changes a URL, sending an additional packet of user specific information to said server identifying said URL;
storing said URLs on said server; and

 processing the history of URLs visited to determine said user's consumer interests,

 wherein said data includes an advertisement matching said user's consumer interests.

References and Rejections

Basso Jr.	US 6,131,090	Oct. 10, 2000
Strubbe	US 7,178,720 B1	Feb. 20, 2007
Boyles	US 2004/017252 A1	Sept. 2, 2004
Stetson	US 2002/0169669 A1	Nov. 14, 2002
Makofka	US 2003/0037330 A1	Feb. 20, 2003
Hoyle	US 6,628,314 B1	Sept. 30, 2003
Sahota	US 2014/0130085 A1	May 8, 2014
Du	US 2001/0042212 A1	Nov. 15, 2001

Kikuchi   US 4,908,692   Mar. 13, 1990

Chan, Mobile Cookies Management on a Smart Card.
Communications of the ACM. Vol. 48, No. 11. November 2005. pp. 38–43.

Claims 1, 5, 10–13, 15, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Basso, Strubbe, and Boyles.

Claims 2–4 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Basso, Strubbe, Boyles, and Dal Canto.

Claims 7 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Basso, Boyles, and Chan.

Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Basso, Strubbe, Boyles, Chan, and Stetson.

Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Basso, Strubbe, Boyles, Makofka, and Hoyle.

Claims 28–31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Basso, Strubbe, Boyles, and Sahota.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Basso, Strubbe, Boyles, and Du.

ANALYSIS

On this record, the Examiner did not err in rejecting claim 1.

We disagree with Appellants' arguments, and agree with and adopt the Examiner's findings and conclusions in (i) the action from which this

appeal is taken and (ii) the Answer to the extent they are consistent with our analysis below.[1]

I

Appellants contend Basso does not teach "reading user specific information *from said smart card* by said client system," as recited in claim 1 (emphasis added). *See* App. Br. 6; Reply Br. 6–8. In particular, Appellants assert:

> [N]owhere does Basso teach or suggest that this certificate is stored on a smart card, as would be required to meet the limitations of the claims. Rather, col. 7, lines 41– 45 state that information is uploaded from the smart card. Then after that information is uploaded, the "individual P returns a certificate" (col. 8, lines 15–24). It therefore appears that this certificate is provided in a separate process than the process of uploading data from the smart card.

App. Br. 6; *see also* Reply Br. 6–8.

Appellants have not persuaded us of error.

In response to Appellants' arguments, the Examiner provides further findings showing Basso teaches "reading user specific information *from said smart card* by said client system," as required by the claim (emphasis added). *See* Ans. 2–6. In particular, the Examiner cites Basso's column 5, lines 26–43 (Ans. 2), which states:

> *The smartcard of individual P includes medical information or other information such as insurance information together with encryption keys, certificates and other data needed to control access to the medical information,* while the *smartcard of provider H includes encryption keys, certificates*

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[1] To the extent Appellants advance new arguments in the Reply Brief without showing good cause, Appellants have waived such arguments. *See* 37 C.F.R. § 41.41(b)(2).

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> *and other information 30 needed to obtain access* to the
> medical information, as will be described further below . . .
>   *it is preferred that at least part of the information needed
> by provider H to access information on the smartcard of
> individual P be stored on one or more smartcards* to increase
> security and to allow individual users of terminal 12 to be
> identified.).

Basso 5:26–43 (emphases added). Further, the Examiner cites Basso's
teaching of "individual P returns a certificate" and subsequently, "[t]erminal
12 receives the certificate of individual P," and determines that "reading user
specific information *from said smart card*" (emphasis added) is taught by or
obvious in light of Basso's teachings. *See* Ans. 3–4 (citing Basso 8:15,
8:24). Appellants fail to persuasively respond to such findings, and,
therefore, fail to show error in the Examiner's findings. In particular,
Appellants simply ignore the cited teachings from Basso's column 5, lines
26–43 and the associated findings by the Examiner. *See In re Baxter
Travenol Labs.,* 952 F.2d 388, 391 (Fed. Cir. 1991) ("It is not the function of
this court [or this Board] to examine the claims in greater detail than argued
by an appellant, looking for [patentable] distinctions over the prior art.").

    Further, Appellants' argument that the Examiner misleads the reader
about Basso's column 7, lines 35–40 (Reply Br. 6–7) contradicts the record.
Basso states:

> *Table 1 shows data* which is *initially provided* to the Trusted
> Authority, provider H *and individual P*; *more particularly the
> data which is stored in* Data processing center 30, terminal 12
> (or which is uploaded from the smartcard of provider H to
> terminal 12), *and the smartcard of individual P*.

Basso's 7:35–40 (emphases added).

Contrary to Appellants' argument (Reply Br. 6–7), the Examiner correctly finds the above Basso excerpt describes storing data at multiple locations, including the smartcard. *See* Ans. 2–3. Therefore, that excerpt supports the Examiner's determination that "reading user specific information *from said smart card*" (emphasis added) is taught by or obvious in light of Basso's teachings.

In addition, Appellants have not persuasively shown Basso's column 7, lines 30–34 render the Examiner's findings—especially the findings based on Basso's column 5 and ignored by Appellants—incorrect. Further, immediately following that excerpt, Basso describes storing data at multiple locations, including the smartcard (Basso 7:35–40), which supports the Examiner's finding (discussed above). *See* Ans. 2–3 (citing Basso 7:35–40).

II

Appellants contend Basso does not teach "reading user specific information from said smart card by said client system, said information including *a user specific electronic serial number*," as recited in claim 1 (emphasis added). *See* App. Br. 6; Reply Br. 8. In particular, Appellants assert:

> [T]hose skilled in the art would not consider such a certificate to be a user specific electronic serial number as set forth in the claims . . . . Those skilled in the art, after reading the specification, would thus clearly appreciate that a trust authority certificate is not a user specific electronic serial number as set forth in the claims.

App. Br. 6 (emphasis omitted); *see also* Reply Br. 8.

In response to Appellants' arguments, the Examiner provides further findings showing Basso teaches the disputed claim limitation. *See* Ans. 5–6. In particular, the Examiner explains why the claimed "a user specific electronic serial number" is taught by or obvious in light of Basso's teachings. *See* Ans. 5–6. Appellants fail to persuasively respond to such findings and therefore, fail to show error in the Examiner's findings. In particular, as discussed above, Appellants' argument that the certificate is not stored on the smart card (Reply Br. 8) is unpersuasive. *See Baxter Travenol Labs.*, 952 F.2d at 391.

<div align="center">III</div>

Appellants contend:

> [N]owhere would the alleged combination teach or suggest blowing a fuse on said smart card after said personal identification data is stored thereon, thereby forming said read-only memory in the smart card. Kikuchi merely teaches a semiconductor fuse. Nowhere does Kikuchi teach or suggest including such a fuse in a smart card, much less blowing such a fuse to create a read-only memory in a smart card, as even further clearly required by the claims.

App. Br. 7 (emphasis omitted); *see also* App. Br. 7–8; Reply Br. 8–10.

Appellants' argument is unpersuasive because the Examiner relies on the combination of Basso, Strubbe, Boyles, and Kikuchi to teach the disputed claim limitation, Appellants cannot establish nonobviousness by attacking Kikuchi individually. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Further, in response to Appellants' argument, the Examiner provides detailed findings as to why the combination teaches the disputed claim limitation (Ans. 6–9), and Appellants fail to persuasively

show error in the Examiner's findings. *See Baxter Travenol Labs.,* 952 F.2d at 391. In particular, Appellants' unsupported attorney arguments (Reply Br. 8–10) are insufficient for showing Examiner error.

In the Reply Brief and for the first time, Appellants belatedly argue about the Examiner's findings in the June 26, 2014 communications. *See* Reply Br. 9. Appellants have waived such arguments because they are untimely, and Appellants have not demonstrated any "good cause" for the belated presentation. *See* 37 C.F.R. § 41.41(b)(2) (2012).

IV

Appellants contend:

> Applicants . . . dispute one skilled in the art would be motivated to combine Kikuchi with Basso, Boyles and/or Strubbe as alleged in the Office Action. Kikuchi is from the art of semiconductor devices, while the other references are in the media access and smart card storage arts. One skilled in the art confronting problems in connection with media access and smart card storage would not look to the non-analogous art of semiconductor devices to solve them.
>
> Kikuchi itself is not specifically directed to the art of read only memories, and one skilled in the art would not consider Kikuchi as a helpful source of information regarding read only memories. Rather, it is directed to the art of semiconductor devices[.]

App. Br. 8.

> The Examiner responds:
> [L]ike Kikuchi, the other cited prior art (i.e., Basso in view of Stubbe and Boyles) are directed to semiconductor devices. A smartcard is itself a semiconductor device. As noted above, Basso shows such a smartcard in Fig.3. In Basso's Fig. 3, item 52 is a microprocessor and item 54 is described as "program and working memory". A

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> microprocessor and programmatically addressable memory are
> both examples of items that utilize semiconductors . . .
>> A read-only memory is an example of a semiconductor-
> based device.

Ans. 9.

> We disagree with Appellants.

> Two *separate* tests define the scope of analogous prior art: (1)
> whether the art is from the same field of endeavor, regardless of
> the problem addressed and, (2) if the reference is not within the
> field of the inventor's endeavor, whether the reference still is
> reasonably pertinent to the particular problem with which the
> inventor is involved.

In re Klein, 647 F.3d 1343, 1348 (Fed. Cir. 2011) (citations omitted)

(emphasis added). "Whether a reference in the prior art is 'analogous' is a

fact question." *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992) (citations

omitted).

Appellants acknowledge "Kikuchi is from the art of semiconductor

devices," and Basso, Strubbe, and Boyles "are in the media access and smart

card storage arts." App. Br. 8.[2] As shown above, the Examiner finds Basso,

Strubbe, and Boyles, and Kikuchi all belong to the field of semiconductor

devices because "[a] smartcard is itself a semiconductor device." Ans. 9.

Appellants have not shown error in the Examiner's findings because

Appellants do not persuasively respond to such findings. *See Baxter*

Travenol Labs., 952 F.2d at 391. In particular, Appellants' conclusory

assertion that the Examiner's finding "is simply not well based" (Reply Br.

11) lacks adequate analysis and is unpersuasive of error.

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[2] Appellants do not contend this invention is not in the field of
semiconductor devices.

Because Appellants have not persuaded us the Examiner erred, we sustain the Examiner's rejection of claim 1.

We also sustain the Examiner's rejection of corresponding dependent claims 2–5, 7–13, 15, 16, 18, 25, and 28–32, which Appellants do not separately argue with substantive contentions.

DECISION

We affirm the Examiner's decision rejecting claims 1–5, 7–13, 15, 16, 18, 25, and 28–32.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED